

## ARGUMENT

In the office action dated June 7, 2004, the Examiner rejected claims 1-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Additionally, the Examiner rejected claims 1-14 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Examiner further rejected claims 1-14 under 35 U.S.C. §103(a) as being unpatentable over Murray (US 6,539,189) in view of Retallick et al. (US 6,189,330).

### 35 U.S.C. §112, SECOND PARAGRAPH:

The Examiner rejected claims 1-14 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner argues that with respect to claim 1, the phrase “ascertaining from the order an appropriate number of appropriately sized containers” is indefinite because the claim previously recites an order for “a shipping container,” which is a singular term. Applicant has amended the claims to better clarify the invention, and in so doing claim 1 recites an order for “an appropriate number of containers,” which can be plural. Hence, the phrase the Examiner cited as indefinite is now definite. Applicant respectfully argues that the Examiner’s rejection under §112 should be withdrawn with respect to this argument in light of Applicant’s amendment.

The Examiner then argues that there is insufficient antecedent basis for the limitation “the container” because the Examiner is unclear whether “the container” refers to the container in the

receiving step or in the ascertaining step. Applicant has amended the claims to better clarify the invention, and in so doing claim 1 now utilizes the term “the containers” instead of the previously used term “the container.” Also, the containers in the ascertaining step and the receiving step both refer to “an appropriate number of containers.” Thus, there is now proper antecedent basis for the term “the containers” because it refers to both, the containers in the receiving step and the containers in the ascertaining step, because both those containers are the same. Applicant respectfully argues that the Examiner’s rejection under §112 should be withdrawn with respect to this argument in light of Applicant’s amendment.

The Examiner next argues that with respect to claim 1, the phrase “undertaking to deliver the goods” is indefinite because the Examiner is unclear what is actually being undertaken. Applicant has amended the claims to better clarify the invention, and in so doing claim 1 now utilizes the phrase “initiating the process of having the goods delivered” instead of the previously used phrase “undertaking to deliver the goods.” This amended phrase is definite because it defines what is being initiated – the process of having the goods delivered. Applicant respectfully argues that the Examiner’s rejection under §112 should be withdrawn with respect to this argument in light of Applicant’s amendment.

Finally, the Examiner argues that with respect to claim 1, the phrase “delivering the goods to” is indefinite because the Examiner is unclear as to how many times the goods is being delivered. Applicant has amended the claims to better clarify the invention, and in so doing the phrase “delivering the goods to” has been deleted from claim 1 so that there is no longer any confusion as to how many times the goods are delivered. The goods are delivered only once. Applicant respectfully argues that the Examiner’s rejection under §112 should be withdrawn with respect to this argument in light of Applicant’s amendment.

Additionally, Applicant has canceled claims 2, 4-10 and 12, thus rendering Examiner's rejection of those claims under 35 U.S.C. §112 as irrelevant.

Applicant respectfully argues that the Examiner's rejection of claims 1, 3, 11, 13 and 14 under 35 U.S.C. §112 should be withdrawn in light of Applicant's arguments and amendments.

35 U.S.C. §101:

The Examiner rejected claims 1-14 under 35 U.S.C. §101 because the Examiner argues that the claimed invention is directed to non-statutory subject matter. The basis for this rejection is set forth in a two-prong test of: 1) whether the invention is within the technological arts; and 2) whether the invention produces a useful, concrete, and tangible result.

Specifically , the Examiner argues that the claimed invention is not within the technological arts, but merely recites an abstract idea; thus, not satisfying the first prong. The Examiner argues that the recited steps of merely receiving an order, ascertaining the number of containers, loading the goods, delivering the goods, monitoring the goods and retrieving the container, does not apply, involve, use or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pen and paper. In amending the claims to better clarify the invention, the invention disclosed in amended claims 1, 11, 13 and 14 does fall within the technological arts.

First, the first element of claim 1 as amended reads "receiving, as a provider of insulated shipping containers, an order from a customer for one or more insulated shipping containers each having a means for thermally managing the contents of the container, such means occupying none of the space within the container in which the goods being shipped are contained." Here, each

container has a means for thermally managing the contents of the container. Support for this amendment is provided in paragraph 9 of the Specification which states “...a heat sink used to absorb infiltrating heat is appropriately chilled (or a heat source used to supplement heat loss is appropriately heated).” Also, the means for thermally managing the contents of the container does not occupy any of the space within the container in which the goods being shipped are contained. Support for this amendment is found in the entire paragraph 3 of the Specification. Paragraph 3 is a description of the prior art and the things wrong with the prior art that Applicant’s method improves upon. Paragraph 3 states “[p]rior art methods for shipping temperature-sensitive goods typically comprise at least the steps of a producer of the goods packing the goods in an insulated container **along with** a heat sink (or heat source) material ....” Since this is a problem with the prior art, Applicants method does not pack both the goods and the heat sink/heat source material in the container. Instead, according to Applicant’s method, the heat sink/heat source material does not occupy any of the space within the container. This element demonstrates two examples of how Applicant’s invention falls within the technological arts as required by 35 U.S.C. §101.

Second, the eighth element of claim 1 as amended reads “monitoring, via wireless communication, real-time data regarding temperature events occurring within the containers and the geographic location of the containers.” Here, each container’s temperature events and geographic location can be monitored via wireless communication. Support for this amendment is provided in paragraph 11 of the Specification which states “[d]uring shipment, the provider, customer, or third party maintains communication access to shipment tracking data such as the container whereabouts or temperature information inside and outside the container 28. Those data are available to the provider, customer, or third party via real-time internet updates.” Since the data is available to the provider, customer, or third party in real-time internet updates, the data must be transmitted from the

container to the internet via wireless communication. This element demonstrates another example of how Applicant's invention falls within the technological arts as required by 35 U.S.C. §101 because this step cannot be performed in the mind of a user or by using a pen and paper.

Finally, claims 11, 13 and 14 have been amended in regards to making the containers ready for future use by conditioning the means for thermally managing the contents of the containers, which includes the cooling of a heat storage material and/or the heating of a heat source material. Support for this amendment is provided in paragraph 9 of the Specification which states “[f]ully charged' means a heat sink used to absorb infiltrating heat is appropriately chilled (or a heat source used to supplement heat loss is appropriately heated).” Claims 11, 13 and 14 each demonstrate how Applicant's invention falls within the technological art as required by 35 U.S.C. §101 because this step cannot be performed in the mind of a user or by using a pen and paper.

In regards to the second prong, the Examiner stated that the claimed invention satisfies the second prong because it produces containers that are used to ship temperature-sensitive goods, where the containers are reusable (i.e., useful and tangible).

Additionally, Applicant has canceled claims 2, 4-10 and 12, thus rendering Examiner's rejection of those claims under 35 U.S.C. §101 as irrelevant.

Since the first and second prongs are both satisfied pursuant to Applicant's amendments, Applicant respectfully argues that the Examiner's rejection of claims 1, 3, 11, 13 and 14 under 35 U.S.C. §101 should be withdrawn in light of Applicant's arguments and amendments.

35 U.S.C. §103(a):

The Examiner argues that this application currently names joint inventors and wishes the Applicant to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a). The Examiner further rejected claims 1-14 under 35 U.S.C. §103(a) as being unpatentable over Murray (US 6,539,189) in view of Retallick et al. (US 6,189,330). Specifically, the Examiner argues that Murray discloses the claimed invention except for Retallick's disclosure of a reusable temperature sensitive container for delivering temperature sensitive goods that include the steps of: 1) providing the containers to the customer before loading and 2) retrieving the container after use and making it ready for future use. The Examiner then argues that it would be obvious to one of ordinary skill at the time the invention was made to combine the two references to modify the container of Murray to be delivered to the customer and recycled according to Retallick, in order to reuse and refurbish the containers for future use.

In response, Applicant states that he is the sole inventor listed on this application and there are no joint inventors.

Also, in response, the Applicant notes that the amendments to claims 1, 3, 11, 13 and 14 also clarify the distinctions with respect to the Murray and Retallick references. Applicant's claim 1 as amended reads "monitoring, via wireless communication, real-time data regarding temperature events occurring within the containers and the geographic location of the containers." Support for this amendment has already been shown in paragraph 4 of the section entitled 35 U.S.C. §101. In Applicant's invention, a provider, a customer, or a third party may monitor real-time temperature events occurring within the containers and the geographic location of the containers via wireless communication. However, in Murray, the purveyor/packer activates a time/temperature alert signal

at the time the perishable goods are packed. The alert of Murray signals “safe” when the temperature does not exceed a preset temperature or the time does not exceed a preset time. If the temperature exceeds the preset temperature or if the time elapses the preset time, the alert of Murray signals an “alarm,” thus signaling the customer that the perishable goods are no longer warranted by the purveyor/packer. The prior art alarm is just a light indicator. Thus, unlike the Applicants invention, a provider, customer or third party utilizing the prior art method may not be able to determine real-time temperature events occurring in the container nor the geographical location of the containers during the delivery process. Additionally, the purveyor/packer does not know when the containers arrive unless the customer transmits a unique transaction identifying alphanumeric code to the purveyor/packer. Hence, the customer must actively perform a step to inform the purveyor/packer. In contrast, in Applicant’s invention, all parties may be able to track the containers’ geographical location and the temperature of the goods within the container. Also, the prior art monitoring system is obviously geared toward having cool goods in the container and not warm goods because the alarm is indicated only when the temperature goes above a preset temperature. In Applicant’s invention, however, cool goods or warm goods may be sent in the containers and the goods will still be monitored. The Retallick reference does not mention the monitoring of the goods during delivery. Applicant respectfully argues that the Examiner’s rejection of claim 1 under §103(a) should be withdrawn.

Applicant’s claim 1 as amended reads “receiving, as a provider of insulated shipping containers, an order from a customer for one or more insulated shipping containers each having a means for thermally managing the contents of the container, such means occupying none of the space within the container in which the goods being shipped are contained.” Support for this amendment has already been shown in paragraph 3 of the section entitled 35 U.S.C. §101. In

Applicant's invention, the means for thermally managing the contents of the container does not occupy any of the space within the container in which the goods being shipped are contained. This feature is not described, suggested, taught or anticipated by Murray or Retallick. In fact, Murray teaches the means for thermally managing the contents of the container to **occupy** the inside of the container. Likewise, in Retallick, the container is partitioned into a plurality of food product storage chambers, some of which may be temperature controlled and others which may not. The insulating materials are placed in the containers as partition walls. However, Applicant's invention utilizes containers which have the means for thermally managing the contents of the container by not occupying the inside of the containers, namely the storage partitions of the containers. Applicant respectfully argues that the Examiner's rejection of claim 1 under §103(a) should be withdrawn.

Further, Applicant's claims 3, 11, 13 and 14 are dependent claims which depend ultimately from now allowable independent claim 1. Thus, the Examiner's rejections of dependent claims 3, 11, 13 and 14 under §103(a) should be withdrawn.

Additionally, Applicant has canceled claims 2, 4-10 and 12, thus rendering Examiner's rejection of those claims under 35 U.S.C. §103(a) as irrelevant.

Applicant respectfully argues that the Examiner's rejection of claims 1, 3, 11, 13 and 14 under 35 U.S.C. §103(a) as being unpatentable over Murray in view of Retallick et al. should be withdrawn in light of Applicant's arguments and amendments.

**REMARKS**

Applicant respectfully requests that this amendment/response be considered by the Examiner and a notice of allowance be entered.

Applicant amended the claims to clarify the structure which applicant believes distinguishes the invention over the cited references. However, amendments have not been made to narrow the claims of the original application but, rather simply, to clarify claims due to grammar that the Examiner found unclear.

If the Examiner feels that a telephone conference with the undersigned would be helpful to the allowance of this application, a telephone conference is respectfully requested.

Respectfully submitted,  
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**CERTIFICATE OF MAILING**

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited on the date shown below with the United States Postal Service, with sufficient postage as First Class Mail (37 CFR 1.8(a)), in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450.

Date: December 7, 2004

Renee Treider